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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/862,472
Filing Date: May 23, 2001
Appellant(s): COFANO ET AL.

David S. Lee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/12/2008 appealing from the Office action mailed April 15, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

Amendment After Final dated July 15, 2008, was filed and entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

The following grounds of rejection is newly added. **Claims 1-7, 9, 16-19** are newly rejected under 35 U.S.C. §101.

NEW GROUND OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-7, 9, 16-19** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The machine-or-transformation test of *In re Bilski* is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.

Certain considerations are applicable to analysis under either branch. In present case there is no machine or transformation.

First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

The present method **claims 1-7, 9, 16-18** as a whole are directed toward "transmitting personal services to the user in accordance with a determined service response"; could be transmitted in writing or verbal. The claims **1-7, 9, 16-18** although tied generally to a computer are not tied to any "particular" machine, so the use of the computer is considered extra-solution activity. The recitation of "computer implemented" in the preamble without a specific recitation in the body of the claim does

not satisfy the statutory requirement of a machine (see also

<http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>).

Examples of extra solution activity are, the transmitting step in paragraph (f) of claim 1 after the preamble does not exclude a verbal transmission and could merely be a doctor walk in the next room and instruct a patient. Further the insertion of reminder from limitation (h) is not specific and for purpose of 101 is considered no more than a post solution activity (i.e. display of data gathered).

So examiner must look to see if there is any transformation of a particular article. For which examiner finds none. It may be asserted that the providing of personal services is the transformation. However, Bilski states on page 28; "Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances."

Appellants' process at most incorporates only such ineligible transformations. . . . the process as claimed encompasses receiving a service request and then based on request determine an appropriate response. Yet the manner in which this is achieved is not claimed with any particular guidance. Thus, the claims does not have the muster to be patent eligible.

Claim **19** is drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible

physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,283,761 B1

Joao

9-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112 1st

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **19-21** and **25-27** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Appellant has amended the claims (ie 19 and the system as well) to read that "a fourth program code that determines a service response to the service request". There is not a teaching in the specification that would enable one of ordinary

skill to build a system and medium with a code that could determine a response. Again there is no teaching that if a user complains/ has certain symptoms that based on those symptoms the system or code would determine/recommend a response.

NEW GROUND OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-7, 9, 16-19** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The machine-or-transformation test of *In re Bilski* is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.

Certain considerations are applicable to analysis under either branch. In present case there is no machine or transformation.

First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

The present method **claims 1-7, 9, 16-18** as a whole are directed toward "transmitting personal services to the user in accordance with a determined service response"; could be transmitted in writing or verbal. The claims **1-7, 9, 16-18** although tied generally to a computer are not tied to any "particular" machine, so the use of the computer is considered extra-solution activity. The recitation of "computer implemented" in the preamble without a specific recitation in the body of the claim does not satisfy the statutory requirement of a machine (see also <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>).

Examples of extra solution activity are, the transmitting step in paragraph (f) of claim 1 after the preamble does not exclude a verbal transmission and could merely be a doctor walk in the next room and instruct a patient. Further the insertion of reminder from limitation (h) is not specific and for purpose of 101 is considered no more than a post solution activity (i.e. display of data gathered).

So examiner must look to see if there is any transformation of a particular article. For which examiner finds none. It may be asserted that the providing of personal services is the transformation. However, Bilski states on page 28; "Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances."

Appellants' process at most incorporates only such ineligible transformations. . . . the process as claimed encompasses receiving a service request and then based on

request determine an appropriate response. Yet the manner in which this is achieved is not claimed with any particular guidance. Thus, the claims does not have the muster to be patent eligible.

Claim **19** is drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-7 and 9 and 16-18 and 19-21 and 25-27** are rejected under 35 U.S.C. 102(b) as being clearly taught by Patent No.: 6,283,761 (Joao).
5. With respect to **Claim 1 and 19 and 20**: Joao discloses

A computer implemented method of providing personal services over a computer network to members of at least one of a plurality of predefined groups, the method comprising the steps of (C 41, 35-40)

a. receiving a service request from a user who is a member of one of the predefined groups (C4, 38-40 "can be used by any party"; C39, 55-60; C39,10-20);

b. determining a user type associated with the received service request (Fig 1 shows four user/terminal types with access to central database, and in Figs 7-15 that shows different user interfaces/flows that are presented depending on user type; Also see C17, 9-12; "For example, a medical specialist can have access to, and/or review, an MRI or a CAT scan for a patient, from any location and at any time.");

c. providing a menu of service request options corresponding to the determined user type (Fig 15A, shows "select training program" which means user was presented with options corresponding to his/her user type, Also see C19, 8-12 restrict access based on user type and C19, 35-40 "dynamically linked");

d. receiving a selection of one of the service request option from the user (Fig 15A "select training program")

e. determining a service response to the service request based on the service request option received from the user (based on selection takes user to next web page, by Fig 15A "transmit training scenario");

f. transmitting personal services to the user in accordance with the determined service response (Fig 15A, 1503 "transmit scenario to individual");

g. recording interactions while providing the personal services to the user (C39, 10-20 and C7, 12-15); and

h. inserting at least one reminder related to the personal services into an electronic calendar associated with the user (C32, 65-68 "update providers schedule" and C33, 15-20 "reminder and C24, 25-30 and C5, 10-18 and C5, 35-40 and C6, 20-25 and C6, 50-55 and C3, 1-14 and Fig 11A 1104 and Fig 11B, 1105"); and

i. presenting statistical information related to the interactions to an administrator for the one predefined group of which the user is a member (C5, 50-60 and C9, 15-20 and C20, 15-25 and C28, 40-45 and C19, 20-28 and C38, 45-55).

6. With respect to **Claim 2**: Joao discloses

wherein the personal services comprises healthcare related services, wherein the predefined groups are respective employers, wherein the user is an employee of one of the employers and is receiving the healthcare related services (C14, 12-20 and C36, 12-16); and

wherein the transmitting of personal services comprises delivering at least one healthcare-related recommendation to the user (C14, 12-20 and C36, 12-16).

7. With respect to **Claim 3**: Joao discloses

wherein the user type comprises one of a member/employee, a service provider, an administrator, and a research service provider (C2, 55-60; C4, 32-58; C26, 39-44 and C28, 10-18).

8. With respect to **Claim 4**: Joao discloses

wherein if the user type is member/employee, the menu of service request options comprises view services available, view news, facilitate communication, update/create user profile, schedule appointment, immediate consultation, perform transaction, check status, provide feedback/comments ((C2, 55-60 and C18, 50-55 and C25, 5-10).

9. With respect to **Claim 5**: Joao discloses

wherein if the user type is service provider the menu of service request options comprises view news, access a knowledge base, facilitate administration, facilitate a feedback query, and facilitate communication (C2, 55-60).

10. With respect to **Claim 6**: Joao discloses

wherein if the user type is administrator, the menu of service request options comprises view news, initiate query, initiate communications, and request help (C25, 5-60 and C18, 50-55 "news" and C37, 35-40 and C41, 34-40).

11. With respect to **Claim 7**: Joao discloses

wherein if the user type is research services the menu of service request options comprise view news, access databases, and initiate queries (C19, 40-46 and C7, 31-40 and C39, 10-20 and C25, 5-60 and C18, 50-55 "news" and C37, 35-40 and C41, 34-40).

12. With respect to **Claim 9**: Joao discloses

wherein recording interactions includes storing information regarding a type of service provided, a user requesting service, service provider information and recommendations, frequency of service provided by user and/or service provider,

feedback from user, and performance-metrics (C4, 20-26 and C39, 10-20 and C39, 28-36).

13. With respect to **Claim 16**: Joao discloses

wherein the enabling of the service response is to be further determined based on information related to a medical history of the user (Besides being inherent in a Doctors response that she would make a determination based upon a medical history ... it is actually shown at C32, 47-48).

14. With respect to **Claim 17**: Joao discloses

wherein the enabling of the service response is to be further determined based on information related to a work schedule of the user (Besides being inherent that one would schedule their doctors visit based upon their availability/ work schedule...actually shown at C32, 47-48).

15. With respect to **Claim 18**: Joao discloses

wherein the enabling of the service response is to be further determined based on information related to an estimated condition of the user (Besides being inherent that a doctor would base his/her response based upon condition of user/patient's health status... actually shown at C32, 47-48 and C38, 34-40).

16. **Claims 19-21 and 25-27** being the system for the method are based on the same analysis.

(10) Response to Argument

The arguments addressed begin on page 7 of 32.

17. In reply to: the 112 1st it is maintained, merely saying that there is a fourth program code that does something is not sufficiently enabled or writtenly described. There is not a teaching in the specification that would enable one of ordinary skill to build a system and medium with a code that could determine a response. Again there is no teaching that if a user complains/ has certain symptoms that based on those symptoms the system or code would determine/recommend a response.

18. In reply to: pg 10 to Appellants assertion that the prior art Joao reference made the same information available to all user types, this is not true. One merely needs to look at Fig 7B, which shows a Doctors' user interface, versus Figure 8A which shows a *different* user interface for the administration/insurance access; which clearly depend on user type. Further support is found in C25, 50-60 wherein one particular user type the providers' communication device/particular user interface the medical doctor can obtain the diagnosis.

19. In reply to: to the assertion that Joao fails to teach inserting at least one reminder into an electronic calendar associated with the user; this assertion is false. Nothing has been claimed that this calendar is unique, and applicant has not even claimed what is argued that Jao fails to teach that a provider must be "granted trusted access or permissions to do so by user". Even if this was claimed this is taught at Jao at C32, 45-65 bridging C33, 1-20. There it specifically teaches an appointment made online and the cpu will "update the provider's schedule to reflect new appointment." This is further demonstrated that there is no distinction in that on fig 11B, it is clearly shown that provider's schedule/calendar is updated automatically.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

Art Unit: 3629

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

MLB

3/18/2009

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/JOHN G WEISS/

Supervisory Patent Examiner, Art Unit 3629

/Vincent Millin/

Appeals Practice Specialist- TC 3600
